

REMARKS

Claims 34, 37, and 114 - 115 have been amended. No new matter has been introduced with these amendments, all of which are supported in the application as originally filed. Claims 1, 9, 11, 14 - 15, 17 - 18, 20 - 24, 28, 34, 37, 90, and 99 - 116 remain in the application.

Applicants are not conceding that the subject matter encompassed by the claims as presented prior to this Amendment is not patentable over the art cited by the Examiner, as claim amendments and cancellations in the present application are directed toward facilitating expeditious prosecution of the application and allowance of the currently-presented claims at an early date. Applicants respectfully reserve the right to pursue claims, including the subject matter encompassed by the claims as presented prior to this Amendment and additional claims, in one or more continuing applications.

I. Rejection Under 35 U. S. C. §102(b)

Paragraph 4 of the Office Action dated July 17, 2007 (hereinafter, "the Office Action") states that Claims 34, 37, and 114 - 115 are rejected under 35 U.S.C. §102(b) as being anticipated by U. S. Patent 5,434,910 to Johnson et al. (hereinafter, "Johnson"). This rejection is respectfully traversed.

A finding of anticipation requires that there must be no difference between the claimed invention and the disclosure of the cited reference as viewed by one of ordinary skill in the art. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 1576, 18

U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). A finding of anticipation requires absolute identity for each and every element set forth in the claimed invention. See *Trintec Indus. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002).

Independent Claim 34, as currently presented, recites:

A method of enhancing voice mail messages for playback to a called party, comprising:
creating a voice mail message for the called party, by a caller using a telephone device;
identifying, by the caller using the telephone device while creating the voice mail message, a plurality of message segments for segmenting the voice mail message;
selecting, by the caller using the telephone device, an audio file from among a plurality of available audio files to insert into the voice mail message between one or more selected pairs of successive ones of the message segments, such that the selected audio file is associated with the selected pair(s) of message segments; and
inserting the selected audio file between the successive ones of the message segments in its associated pair(s) as the voice mail message is played back to the called party. (emphasis added)

Applicants respectfully note that Johnson describes creating a voice mail message to be used as a greeting for a called party's voice mail system, where this greeting will be played back to a calling party (i.e., a caller). See, for example,

- Abstract, lines 11 - 15, "In response to a query from a caller ... the audio message is [played back]" (emphasis added);
- col. 1, lines 62 - 66, "... a specific message that may be presented in response to a call ..." (emphasis added);
- col. 2, lines 10 - 12, "... for presentation to the caller" (emphasis added);

- col. 2, lines 16 - 20, “In response [to] a query from a caller ...” (emphasis added);
- col. 2, lines 29 - 37, “In response to a ... query by a caller ...” (emphasis added);
- col. 2, lines 43 - 49, “In response to a query from a caller ...” (emphasis added);
- col. 5, line 47 - col. 6, line 7 provide examples of customizing the information in a greeting (referred to at line 47 as a “prerecorded message”), including customizing the greeting to reflect the called party’s electronic calendar and customizing the greeting with reference to the current date, and lines 52 - 57 of col. 5 state that a preferred embodiment enables users to “provide a caller” (emphasis added) with various kinds of information;
- col. 6, lines 17 - 23, “When the message is played as a result of a call or query by a caller ...” (emphasis added);
- col. 6, lines 36 - 43, “Although the depicted embodiment ... responds to queries from callers ...” (emphasis added), and then stating that the messages could also be presented “in response to a signal not originating from a query”, such as sending messages at predetermined times or in response to an event;
- col. 12, lines 34 - 36, “... output of the message to audio for presentation to the caller ...” (emphasis added); and
- col. 13, lines 18 - 29, discussing messages that may be created by a called party (referred to therein as “a user”) for presenting to a caller (i.e., as a voice mail greeting) when the called party is not answering because he or she is away at lunch.

This is in contrast to Applicants' claimed invention as recited in Claim 34, where the caller is creating the message (see Claim 34, lines 3 - 4, "creating a voice mail message ... by a caller ...") and the message is played back to the called party (see Claim 34, lines 1 - 2, lines 3 - 4, and lines 11 - 12 "... as the voice mail message is played back to the called party"). Accordingly, Applicants respectfully submit that the above-underlined limitations of Claim 34 are different from what is taught by Johnson.

Accordingly, differences exist between Applicants' claimed invention as recited in Claim 34 and the disclosure of Johnson. Claim 34 is therefore not anticipated according to the holding in *Scripps Clinic & Research Foundation*. Furthermore, absolute identity is not found in Johnson for each and every element set forth in Applicants' claimed invention, and Claim 34 is therefore not anticipated according to the holding in *Trintec Indus.*

Claim 34 is therefore deemed patentable over Johnson. Independent Claim 114 recites claim limitations analogous to those of Claim 34, and is therefore deemed patentable over Johnson for the same reasons. Dependent Claims 37 and 115 are deemed patentable by virtue of (at least) the patentability of the independent claims from which they depend.

The Examiner is therefore respectfully requested to withdraw the §102 rejection.

II. First Rejection Under 35 U. S. C. §103(a)

Paragraph 7 of the Office Action states that Claims 1, 9, 18, 20, 22, 28, 99 - 102, 107 -

109, 111 - 113, and 116 are rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent 5,943,402 to Hamel et al. (hereinafter, "Hamel") in view of U. S. Patent 7,203,286 B1 to Brockenbrough. This rejection is respectfully traversed.

Applicants submit herewith a Declaration of Fact Under 37 C.F.R. §1.131 from all of the named inventors (hereinafter, "declaration"). This declaration demonstrates that the invention, as claimed herein in (*inter alia*) independent Claims 1, 34, 100, 111, and 114, was conceived prior to October 6, 2000, the priority date of Brockenbrough. The declaration also shows that due diligence was exercised from a time before October 6, 2000 through the filing of the parent application on February 13, 2001.

In view of the declaration, Applicants respectfully submit that Brockenbrough should be removed as a reference. (Applicants respectfully note that if Brockenbrough is not a reference as to their independent claims, then Brockenbrough is also not a reference as to their dependent claims.)

The Office Action admits that Hamel does not teach "that one of the actions performed on a voicemail segment is associating a background sound", referring to Applicants' independent Claim 1 (Office Action, p. 5, lines 1 - 2), and indicates (Office Action, p. 6, lines 7 - 9 and lines 15 - 20) that independent Claims 100 and 111 are "substantially similar" to the method as claimed in Claim 1. Reference is made to the rejection of Claim 1 when discussing both Claims 100 and 111 (Office Action, p. 6, lines 9 and 19 - 20). With removal of Brockenbrough as a reference, and the

admission in the Office Action that Hamel does not teach all limitations of Claim 1, a *prima facie* case of obviousness is not made out as to these independent claims under 35 U.S.C. §103.

Without more, independent Claims 1, 100, and 111 are deemed patentable.

In the alternative, Applicants respectfully submit that Brockenbrough does not teach claim elements claimed by Applicants. In particular, Brockenbrough discusses use of a single background sound, and no discussion or suggestion is found in Brockenbrough of “identifying ... at least two of the message segments which are to have background sounds associated therewith” (Claim 1, lines 5 - 6, emphasis added); “selecting, for each of the identified message segments ... a sound to be associated therewith ... wherein the sounds ... for at least two of the message segments are different sounds” (Claim 1, lines 7 - 9, emphasis added); or “... playing back at least two of the identified message segments for which a sound was selected ... while concurrently playing back the sound selected ... for each of the [at least two] played-back ... message segments ... such that the background sound played back ... changes at least once during the playback” (Claim 1, lines 10 - 16, emphasis added). It is clear that Hamel also does not teach these claim elements, because – as admitted on p. 5, lines 1 - 2 of the Office Action – Hamel does not teach associating background sound with a voicemail segment. Accordingly, because neither Hamel nor Brockenbrough teaches the above-discussed limitations of Applicants’ Claim 1, Applicants submit that a *prima facie* case of obviousness is not made out under 35 U.S.C. §103, and without more, independent Claim 1 is deemed patentable. Claims 100 and 111 are therefore deemed patentable for the same reasons.

Dependent Claims 9, 18, 20, 22, 28, 99, 101 - 102, 107 - 109, 112 - 113, and 116 are therefore deemed patentable by virtue of (*inter alia*) the patentability of Claims 1, 100, and 111, from which they depend.

In view of the above, the Examiner is respectfully requested to withdraw the §103 rejection of Claims 1, 9, 18, 20, 22, 28, 99 - 102, 107 - 109, 111 - 113, and 116.

III. Second Rejection Under 35 U. S. C. §103(a)

Paragraph 8 of the Office Action states that Claims 11, 15, 103, and 105 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Brockenbrough and further in view of U. S. Patent 6,125,175 to Goldberg. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claims 1 and 100 are patentable over Hamel and Brockenbrough. Accordingly, dependent Claims 11, 15, 103, and 105, which depend therefrom, are deemed patentable by virtue of (at least) the patentability of the independent claims. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claims 11, 15, 103, and 105.

IV. Third Rejection Under 35 U. S. C. §103(a)

Paragraph 9 of the Office Action states that Claims 14 and 104 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Brockenbrough and further in view of U. S. Patent 6,634,992 B1 to Ogawa. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claims 1 and 100 are patentable over Hamel and Brockenbrough. Accordingly, dependent Claims 14 and 104, which depend therefrom, are deemed patentable by virtue of (at least) the patentability of the independent claims. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claims 14 and 104.

V. Fourth Rejection Under 35 U. S. C. §103(a)

Paragraph 10 of the Office Action states that Claims 17 and 106 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Brockenbrough and further in view of U. S. Patent 6,407,325 to Yi. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claims 1 and 100 are patentable over Hamel and Brockenbrough. Accordingly, dependent Claims 17 and 106, which depend therefrom, are deemed patentable by virtue of (at least) the patentability of the independent claims. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claims 17 and 106.

VI. Fifth Rejection Under 35 U. S. C. §103(a)

Paragraph 11 of the Office Action states that Claim 21 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Brockenbrough and further in view of Newton's Telecom Dictionary. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claim 1 is patentable over Hamel and Brockenbrough. Accordingly, dependent Claim 21, which depends therefrom, is deemed patentable by virtue of (at least) the patentability of the independent claim. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claim 21.

VII. Sixth Rejection Under 35 U. S. C. §103(a)

Paragraph 12 of the Office Action states that Claims 23 - 24 and 110 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Brockenbrough and further in view of U. S. Patent Publication 2002/0082838 A1 to Hinde. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claims 1 and 100 are patentable over Hamel and Brockenbrough. Accordingly, dependent Claims 23 - 24 and 110, which depend therefrom, are deemed patentable by virtue of (at least) the patentability of the independent claims. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claims 23 - 24 and 110.

VIII. Seventh Rejection Under 35 U. S. C. §103(a)

Paragraph 13 of the Office Action states that Claim 90 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hamel in view of Brockenbrough and further in view of U. S. Patent 5,850,431 to Satou. This rejection is respectfully traversed.

Applicants have demonstrated, above, that independent Claim 1 is patentable over Hamel

and Brockenbrough. Accordingly, dependent Claim 90, which depends therefrom, is deemed patentable by virtue of (at least) the patentability of the independent claim. The Examiner is therefore respectfully requested to withdraw the §103 rejection of Claim 90.

IX. Conclusion

Applicants respectfully request reconsideration of the pending rejected claims, withdrawal of all presently outstanding rejections, and allowance of all remaining claims at an early date.

Respectfully submitted,

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